

Docket No. 36-0032

C. Moore

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)

Ramon Coronel, et al.)

Serial No.: 09/618,708)

Filed: July 18, 2000)

For: LARGE MULTI-FUNCTION
INTEGRATED CIRCUIT DEVICE)

Group Art Unit: 2814

Examiner: Willie, Douglas A.

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PETITION TO THE COMMISSIONER UNDER 37 C.F.R. § 1.181

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Assistant Commissioner for Patents
Washington, DC 20231

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TECHNOLOGY CENTER 2800

Sir:

Applicant petitions to request that the Examiner's restriction requirement in the application identified above be withdrawn and that the claims removed from consideration, except those cancelled by Applicant, be reinstated and considered by the Patent and Trademark Office in subsequent proceedings involving this application.

STATEMENT OF FACTS:

1. The Examiner made a telephonic restriction requirement on December 11, 2001, and asserted that there were four separate inventions, comprising:

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- Group I: Claims 1-5 and 37
- Group II: Claims 6-18 and 38
- Group III: Claims 19-23 and 39
- Group IV: Claims 24-36 and 40

The undersigned attorney declined to make an election because claim 6 was a dependent claim of claim 1.

2. In an Office action dated January 22, 2002, the Examiner made the same restriction requirement in writing. In brief, the Examiner argued that Inventions I and II are related as combination and subcombination, that Inventions I and III are related as combination and subcombination, and that Inventions III and IV are related as combination and subcombination.

3. In a Response to Restriction Requirement filed February 5, 2002, Applicant argued that:

(a) Restriction as between Groups I and II was improper because the claims of Group II all depend from a claim of Group I.

(b) Restriction as between Groups III and IV was improper because the claims of Group IV all depend from a claim of Group III.

(c) Any claim that depends from an independent claim cannot be a subcombination of the structure defined by the independent claim, and this principle is made abundantly clear in the examples of combination and subcombination claims set forth in MPEP Section 806.05(c).

4. In an Office action dated March 4, 2002, the Examiner made the restriction requirement final.

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5. In an Amendment filed July 3, 2002, Applicant again argued that the restriction requirement was improper, and requested that the Examiner reconsider and withdraw the requirement.

6. In an Office action dated August 21, 2002, the Examiner noted that the restriction requirement was final and would not be considered further.

ARGUMENT:

Applicant has argued that a second claim that depends from a first claim cannot be a subcombination of the first claim. Further, a second group of claims, each member of which depends from one of a first group of claims cannot be said to define a subcombination of the invention defined by the first group.

In MPEP §806.05(c), example one, the following statement is made: "Where a combination as claimed does not set forth the details of the subcombination as separately claimed, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction." (Emphasis added.)

When two claims are related as dependent and independent, the inventions defined therein are surely not "separately claimed" for purposes of restriction. The dependent claim includes, of course, all the features of the independent claim and cannot, therefore, define a "subcombination" of those features. Applicant has been unable to ascertain from the Examiner's actions which portions of the claims in question define a subcombination and which portions define a combination. For example, claim 1 as filed defines a combination of six recited elements, and claim 6 as filed depends from claim 1 and recites more specifically the structure of one of those elements. Yet claims 6 is said to define a different invention (Group II) from claim 1 (Group I). This

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conclusion is logically inconsistent with the fact that claim 6 includes all of the features of claim 1.

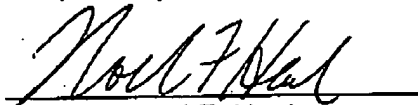
Applicant believes that the Examiner's restriction requirement is totally at odds with the principles of restriction practice as defined in the MPEP, and in particular is inconsistent with the examples of proper restriction as set forth in the MPEP.

Reconsideration and withdrawal of the restriction requirement are respectfully requested.

The Patent Office is authorized to charge the Petition Fee of \$130 to the Deposit Account 20-1515.

Respectfully submitted,

Date: February 20, 2003



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The following papers listed below are submitted:

(13 pages, including transmittal cover) (FAX 703-872-9319)

1. Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences in Duplicate
2. Petition to the Commissioner Under 37 C.F.R. Section 1.181 in Duplicate
3. Petition for Extension of Time Under 37 C.F.R. 1.136(a) in Duplicate

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